

Application No. 10/717,869
Amendment dated August 11, 2004
Reply to Office Action of May 13, 2004

REMARKS

The examiner has rejected claims 1 through 5 as obvious over Suzuki et al US '652, Suzuki GB '568, and WO '584. At the outset Suzuki US '652 is the same as Suzuki GB, and henceforth applicants will only refer to Suzuki. The Examiner stated that "none of the references quantify the surface roughness or smoothness of the sheet; however, this seems to be inherent to the reference or at least a recognizable optimization variable. . .". The latter is an incorrect assumption and the examiner can not assume the references inherently disclose the smoothness and opacity of the claims herein. Hence, applicants respectfully traverse the outstanding obviousness rejection of the claims. No reference suggests the claimed combination.

Claims 1 and 3 have been amended to correct typographical errors. The reference to 4.5 μm in claim 1 has a basis at page 2, line 20 of the specification. Claim 3 is an obvious typographical error, but Table 1 at page 13 of the specification shows mechanical pulp at 100%. Claims 1 and 3 have been amended, no claims have been cancelled, claims 8 to 10 have been added and claims 1 to 10 are pending.

The References.

Suzuki is directed to a medium grade coated paper which is suitable for gravure printing by virtue of avoiding missing gravure dots. Suzuki asserts he avoids missing gravure dots with a specific fibre distribution where there must be below 30 weight percent of 42 mesh fibres, and it is best if there is below 5 weight percent of these 42 mesh fibres. While Suzuki does describe coated paper with brightness of below 80% (see column 3, ln 66), he does not disclose opacity or roughness.

WO/'584 describes a method for making paper where a glyoxalated polyacrylamide is added to a wet mechanical pulp to maintain or increase the strength of the paper made from the mechanical pulp. The reference describes the paper having an opacity of at least 85%, but does not describe roughness, brightness or particles size distribution.

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The Pending Claims Are Non-obvious Over the References.

For a reference to inherently disclose a feature of the invention, the reference must *necessarily* have the feature of the invention. *In re Robertson et al.*, 169 F.3d 743 (Fed. Cir 1999). That is not the case here. Suzuki describes only brightness, but does not disclose opacity, roughness or the claimed particle size distribution.

WO/'584 does not describe brightness or roughness. Merely describing an opacity of at least about 85% does not mean the paper will have the roughness, brightness or particle size distribution as claimed. See attached declaration.

Applicants have found a way of making paper having good properties such as tear strength, stiffness, bulk, but do it inexpensively with mechanical pulp. The references do not solve the same problem solved by applicants, nor do they inherently provide a paper with the same properties.

In connection with the new claims, the references do absolutely nothing to suggest a combination of particle size with brightness, opacity, smoothness and other characteristics of the claimed paper.

Conclusion.

In view of the above discussion, applicants respectfully request reconsideration and allowance of the pending claims.

Respectfully submitted,

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